

Response Under 37 C.F.R. 1.116

Applicant: Kenneth M. Adams et al.

Serial No.: 10/657,915

Filed: September 9, 2003

Docket No.: M190.145.101 / P0000263.00 US

Title: SURGICAL MICRO-BURRING INSTRUMENT AND METHOD OF PERFORMING SINUS SURGERY

REMARKS

This is responsive to the Final Office Action mailed October 5, 2009. Applicants further reiterate all previous arguments with regard to the allowability of the pending claims. Additional arguments for the allowability of the claims are provided below.

Claims 1-13, 15-24 and 31-36 remain pending in the application and are presented for reconsideration and allowance.

35 U.S.C. §102 Rejections

Claims 1, 10, 13, 15-20, 22-23, 31-32 and 34-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Anctil et al., U.S. Patent No. 5,922,003 ("Anctil"). The disclosure of Anctil is primarily directed to an angled rotary tissue cutting instrument and is concerned with various embodiments that are directed to locations of bends along the cutting instrument and configuring outer and inner tubular members to conform to a desired bend. Of the different embodiments, Anctil illustrates three different distal end configurations. With specific regard to the distal end configurations that are disclosed, Anctil notes that the distal end of an outer tubular member is suitably configured to cooperate with a particular configuration of a distal end of the inner tubular member. *See Anctil, col. 9, l.66 to col. 10, l.4.* That is, depending on a particular cutting element, a particular window configuration is chosen. In FIG. 1, a serrated window 30 is used with a serrated cutting tip 38. Alternatively, in the embodiment shown in FIG. 20, wherein a bur 788 is utilized, cutting window 730 is suitably configured in a large open configuration so as to accommodate bur 788. The embodiment in FIG. 26 illustrates yet another alternative embodiment, wherein a small hemispherically shaped opening 830 is positioned at a distal end in order to accommodate cutting tip 838.

In the Office Action, the Examiner has arbitrarily chosen features from these separate and distinct embodiments in order to create different window configurations that are not particularly disclosed. Moreover, it appears that the Examiner has used impermissible hindsight in an attempt to reject the claim features of claim 1. For example, the embodiment of FIG. 1 does not include a bur or exposing a bur relative to an outer tubular member. The embodiment of FIG.

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20, which does illustrate a bur, does not disclose three separate zones or a pocket with an elevator tip distal the pocket. Even if one were to put serrations on window 730 in the embodiment of FIG. 20, window 730 would still not include an elevator tip that extends distal a pocket. The embodiment of FIG. 26 does not disclose the three separate zones, an elevator tip or a bur.

Moreover, several of the dependent claims are neither taught nor suggested by the distinct distal configurations provided in Ancil. For example, claim 13 recites that the intermediate zone is parallel with the central axis of the proximal portion. However, in the serrated illustration provided by the Examiner, the intermediate zone is not parallel with a central axis of the proximal portion. Thus, this feature is separately patentable over Ancil.

With regard to claim 19, the aspiration passage of Ancil is simply not formed at a distal end of the bur as illustrated in FIG. 23. Instead, a hole 750 is formed proximal to the distal end of the bur. As a result, the disclosure of Ancil does not support a rejection of claim 19 and thus is separately patentable.

With regard to claim 23, the Examiner has not provided any objective evidence that discloses where the elevator tip is selectively axially moveable to the bur. Instead, it appears that the alleged elevator tip, which is simply the end of the outer tube, is fixed relative to the bur. Thus, claim 23 is separately patentable.

With regard to claim 31 and 32, the angled serrated opening as illustrated in FIG. 1 of Ancil does not include a bur. Thus, these features are patentable over Ancil.

35 U.S.C. §103 Rejections

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ancil. Furthermore, claims 2-9, 11-12 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ancil in view of Adams, U.S. Patent No. 6,503,263. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ancil in view of West, Jr., U.S. Patent No. 5,364,395.

With regard to claim 33, the only embodiment in Ancil or Adams that illustrates a distal end opening such that the distal most end is below a central axis of the lumen is FIG. 20.

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However, FIG. 20 does not suggest an elevator tip extending distal a pocket or the separate zones as recited. Instead, bur 788 is open on all sides at a distal end so as to cooperate with the opening 730. No suggestion for utilizing a pocket configuration as recited in claim 33 is provided. For at least these reasons, claim 33 is separately patentable.

CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1-13, 15-24 and 31-36 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1-13, 15-24 and 31-36 are respectfully requested.

No fees are required under 37 C.F.R. 1.16(b)(c). However, if such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 50-0471.

The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application.

Any inquiry regarding this Amendment and Response should be directed to Todd R. Fronek at Telephone No. (612) 767-2522, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

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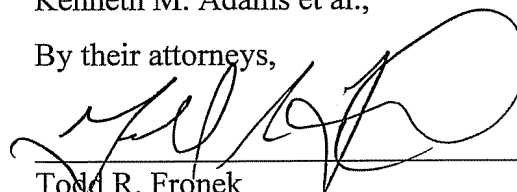
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Respectfully submitted,

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By their attorneys,



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Date: 12/7/09
TRF:skh